

REMARKS

Claims 1, 3 and 8-11 are pending. Claim 1 has been amended to incorporate the limitation of claim 2 and claim 2 has been canceled. No new matter has been added.

In view of the above amendments and remarks below, applicants respectfully request withdrawal of each of the rejections and allowance of the application.

Claim Rejections – 35 USC 103

Claims 1 and 3 were rejected under 35 USC 103(a) as being unpatentable over Prior art figures 9A-9B in view of Ozimek et al. (5,382,310) and Sasano (US 6,313,525 B1).

Claims 2 and 8-10 are rejected under 35 USC 103(a) as being unpatentable over Prior art figures 9A-9B, Ozimek et al., Sasano and in further view of Toshiba KK[Toke] (JP 07225391A).

Original independent claim 8 recites a semiconductor device that includes a transparent plate with a light-shielding adhesive resin provided over the transparent plate's entire surface. Claim 1 has been amended to recite a semiconductor device that includes a light-shielding adhesive resin. That limitation is incorporated from original dependent claim 2 and, thus, claim 2 has been canceled. No new matter has been added.

The Office action states, with respect to claim 2 and 8-10, that it would have been obvious to one of ordinary skill in the art to modify the device structure of alleged Prior Art Figures 9A-9B, the adhesive of Ozimek and the glass plate, adhesive and external connection of Sasano with the light shielding adhesive resin of Toshsiba.

The Office action, however, fails to identify any motivation or suggestion for combining the prior art. In particular, the Office action appears to be improperly using the Applicant's disclosure as a blueprint for selecting the prior art to support the conclusion for obviousness. In other words, the Office action is using improper hindsight.

The teachings of Toshiba are incompatible with Sasano and Ozimek. Sasano is directed to an imaging device that includes a transparent sealing plate 9 bonded to the upper surface of the package body 1 through transparent adhesive 10 composed of an ultraviolet-curable resin

(column 5, lines 57 to 61). Ozimek et al. shows an image sensor 10 that includes transparent adhesive 26 bonded to a glass plate 28 (column 3, lines 9-31). In contrast, Toshiba discloses a liquid crystal displaying module in which an IC driver 31 sits on a non-transparent adhesive (i.e. light-shielding) resin 36. The devices of Sasano and Ozimek are directed to imaging devices and require transparent layers to allow light to enter the devices to operate properly. Modifying such imaging devices, as suggested by the Office action, by applying the non-transparent adhesive of Toshiba to the devices, would prevent light from entering the imaging devices, thereby destroying the functionality of the devices. Therefore, one skilled in the art would not have been led or motivated to combine the teachings of Sasano and Ozimek having a transparent adhesive with the teachings of Toshiba having a non-transparent adhesive. Accordingly, claims 8 to 10 are non-obvious over the prior-art.

Moreover, the LCD structure of the Toshiba invention is so dissimilar with Sasano's hollow package structure or Figs. 9A and 9B's structure that a person of ordinary skill in the art would not have been led or motivated to combine the disclosure of Toshiba with either Sasano or the admitted prior art. Even if the references are combined, there is no suggestion or teaching in any of the prior art references to use the light shielding adhesive resin as claimed in claim 8. Claims 8 to 10 are thus non-obvious for the foregoing reasons.

Furthermore, none of the cited references teach or suggest "a terminal provided on a back of the substrate and electrically connected to the circuit member through the substrate" as recited in claim 8. Claims 8 to 10 are nonobvious for that additional reason as well.

Claim 11, which depends from claim 8, was rejected under 35 USC 103(a) as being unpatentable over Prior art figures 9A-9B, Ozimek et al., Sasano, Toshiba, in further view of Hyoudo et al. (US 6,365,433 B1). The Hyoudo et al. patent does not cure the deficiencies in the prior art discussed above with respect to claim 8. Therefore, claim 11 should be allowable as well.

For the reasons explained above, claim 8 should be allowable. Since claim 11 depends from claim 8, claim 11 should be allowable for at least the same reasons.

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Conclusion

Applicant asks that all claims be allowed.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Arthur Ortega
Reg. No. P-53,422

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, New York 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291